

## **REMARKS**

This amendment is responsive to the Office Action mailed on October 3, 2001. Attached hereto, therefore, are a request for a three-month extension of time and the appropriate fee.

### **Paragraphs 1 to 4 - Informalities**

The patentee gratefully acknowledges the Examiner's identification of certain minor informalities in the specification and claims.

As to the specification, the patentee has endeavored to address each of the Examiner's concerns in the above-noted amendments to the specification that have been provided in accordance with 37 C.F.R. 1.173 (b)(1) and 1.173(d). The only amendment differing slightly from the Examiner's suggestion is the replacement paragraph beginning at column 6, line 9. It was not the patentee's intent to cancel "the horizontal ... Conveyor 24" altogether, but rather to include such language in a parenthetical.

As to the claims, the patentee has amended Claims 38, 42, 45, 49, 52 and 55 as noted above by including the entire text of each claim being changed in accordance with 37 C.F.R. 1.173(b)(2) and by including the marking required by 37 C.F.R. 1.173(d). Claims 38, 45 and 52 have been amended to remove any reference to a "wall" since it is sufficient, the patentee respectfully submits, to refer to a hopper without unduly limiting the claim to the geometric details associated with the walls of any particular hopper configuration. Claims 42, 49 and 55 have been amended as suggested by the Examiner.

The patentee invites the Examiner to contact the undersigned attorney if any further issues of this nature become apparent.

#### **Status of Claims and Support for Claim Changes**

In accordance with 37 C.F.R. 1.173(c), the patentee has attached an appendix hereto containing the above-noted changes to the claims, an indication of the status (i.e., pending or canceled) of all patent claims as of the date of this amendment, and an explanation of the support in the disclosure of the patent for the changes made.

#### **Paragraphs 5 to 6 – Rejection of Claims 38-57 Under Section 112**

The patentee has carefully amended the claims in view of the Office Action's Section 112 concerns, without adding new matter. The reference to a "wall" has been removed altogether so that there is no need to describe such walls. The antecedent issue relating to "said rotating" in Claims 41, 48 and 54 has been resolved amending the claims to specify that "said [rotating] forcing is accomplished by rotating the shaft with a motor." The antecedent issue relating to "the movement" in claims 44, 51 and 57 has been resolved by deleting "the" as suggested by the Examiner.

#### **Paragraphs 7 to 8 – Reissue Declaration**

The Office Action objects to the reissue declaration in this application on the basis that the subject declaration applies only to the parent. The patentee respectfully traverses.

There were three reissue declarations filed in the parent application<sup>1</sup>. In each declaration, the inventor states that he believes the patent to be "wholly or partly inoperative" "by reason of the patentee claiming more or less than he had the right to claim in the patent." Applicant respectfully submits that this generic language clearly covers the present continuation reissue application.

The patentee presumes that the Examiner may be focusing on the prior declarations' exemplary indication that "The claims directed to a 'Diverter Gate' are too narrow." However, that statement was only inserted in compliance with 37 C.F.R. 1.175(a)(1) which simply requires that the reissue declaration state "at least one error being relied upon as the basis for reissue." Obviously, therefore, there can be other errors than the "at least one" that is specifically listed, such as those at issue in this application.

Based on the foregoing, Applicant respectfully submits that the reissue declarations already of record are effective.

#### **Paragraph 10 – Rejection of Claims 38-57 Under 35 U.S.C. 251**

The Office Action rejects Claims 38-57 under 35 U.S.C. 251 as being impermissible broadened in a reissue application filed outside the two year statutory period. Applicant respectfully requests reconsideration of this rejection as it either ignores applicant's priority claim or is based on a misinterpretation of the law.

The statutory patent law relating to reissue applications is set forth in 35 U.S.C. 251 which reads as follows (emphasis added):

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<sup>1</sup> The patentee was forced to submit a Rule 1.47(a) Petition because one of the inventors refused to sign.

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

In regard to this particular reissue application, patent no. 5,635,235 issued on June 3, 1997. A parent reissue application was filed on June 3, 1999, i.e. before the expiration of the two years broadening period defined by the fourth paragraph of 35 U.S.C. 251 (underlined above)<sup>2</sup>.

This continuation reissue application seeks to broaden the claims of the surrendered patent based on its priority rights to the filing date of the parent reissue application that qualifies for broadening:

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<sup>2</sup> On January 2, 2001, the parent reissue application no. 487,040 matured into reissued patent no RE37008.

Under the Court's interpretation of 35 U.S.C. 251, the submission of broadening claims after the two year period is permissible so long as the public was placed on notice of the patentee's intention to enlarge the claims through the prior submission of broadening reissue within the two year broadening period. See, e.g. In re Doll, 164 U.S.P.Q. 218 (CCPA 1970), but c.f. In re Graff, 111 F.3d 874, 42 U.S.P.Q.2d 1741 (Fed. Cir. 1997).

The facts of In re Doll are similar to ours. In the 1970 In re Doll decision, the CCPA held that an applicant may submit broadening claims within a reissue application after the two year broadening period so long as the applicant had already submitted broadening claims, even different claims, before the expiration of the two year broadening period<sup>3</sup>.

The Board refused to grant Doll's claims based on 35 U.S.C. 251.

According to the CCPA, 164 USPQ at 219, the issues presented by In re Doll were:

(1) Whether claims presented in a reissue application filed within two years of the original patent grant are barred by 35 U.S.C. 251 when such claims are not submitted until more than two years after the grant and are broader in scope than both the original patent claims and the broadening reissue claims originally submitted, and

(2) Whether the reissue oath originally filed with the reissue application is adequate to support the newly submitted claims.

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<sup>3</sup> On 10/31/57, before the expiration of the two year broadening period, the In re Doll applicant filed a reissue application with some additional claims that that were broader than the original claims. The new claims were copied from another patent in order to invoke an interference. The interference was subsequently terminated. On 7/28/60, after the expiration of the two year broadening period, the applicant copied some other claims from a second patent. During the second interference, also after the expiration of the two year broadening period, the applicant copied even more claims from a third patent.

The CCPA reversed the Board and held that the later filed claims are not barred by 35 U.S.C. 251 because the statute's "applied for" language simply refers to the filing of an application, not when the broadening claims are presented in such application. Id. At 220. The CCPA further held that the applicant's reissue oath was adequate.

In the 1997 In re Graff decision, the issue of later submitted claims was addressed within the context of a several continuation reissue applications. In re Graff distinguished In re Doll by holding that broadened claims may not be submitted in a continuation reissue application filed after the two year period when the patentee had not sought to enlarge the scope of the claims before the expiration of the two year period.

The pertinent facts of In re Graff are as follows. On 10/23/84, the PTO issued the Graff Patent. On 7/29/96, before the expiration of the two year broadening period, Mr. Graf filed a non-broadening<sup>4</sup> (!!!) reissue application to correct an error in Figure 5. In the first Office Action, the Examiner rejected Graff's claims as obvious over a newly cited reference. On 2/2/98, now several years after the two year broadening period of 35 U.S.C. 251, Graf filed an amendment that changed some claims without affecting their scope and broadened others. Graf included a new declaration "in a form appropriate to broadening reissue applications" and argued for patentability over the cited reference. On 6/27/90, notwithstanding the CCPA's In re Doll decision, the PTO rejected all of the broadened claims on the ground that Mr. Graff had not applied for a reissue patent enlarging the scope of the claims within the two year statutory period for

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<sup>4</sup> The present application's parent applications was, by contrast, a broadening application.

filing broadening reissue applications. The PTO did, however, allow the claims of unchanged scope.

In response, Graff elected to secure a reissue patent with the corrected drawings and allowed claims, while prosecuting the broadened claims in a continuation application. On 3/8/91, therefore, Graf filed a continuation of his reissue application containing only the broadened claims. After the broadened claims were again rejected for being filed after the two year period, Graf appealed to the Board in reliance on In re Doll, arguing that "it was sufficient that he had filed a non-broadening reissue application within the two year period". In re Graff, 42 U.S.P.Q.2d at 1472. The Board, however, distinguished In re Doll on its facts and affirmed that the continuation reissue application could not be granted. Graff then appealed the Board's decision to the U.S. Court of Appeals for the Federal Circuit.

The Federal Circuit noted that the situation then before them in In Re Graff was unlike In re Doll which (like this case!) involved a broadening application that was filed before the expiration of the two year period. In re Graff, 42 U.S.P.Q.2d at 1472.

The Federal Circuit, at 1741, affirmed the Board as follows:

We conclude that the reissue statute requires that proposals to broaden a patented invention must be brought to public notice within two years of patent issuance. The interested public is entitled to rely on the absence of a broadening reissue application within two years of grant of the original patent.

This case, however, is not at all like In re Graff because Graff first submitted broadening claims more than two years after grant. This case, rather, is like In re Doll in that the patentee here filed a broadening reissue application before the expiration of the two year period. It makes no difference that the claims of this

continuation reissue application are different than the claims in the parent reissue application since In re Doll presented that same fact situation (claims added after two year period different than those presented before end of two year period).

The purpose of the statute, as noted by the Federal Circuit in In re Graff, is simply to put the public on notice that the patentee proposes to broaden the patent claims. That has been done here since the patentee here, like the patentee of In re Doll, sought to broaden the claims before the expiration of the two year period.

Based on the foregoing analysis of 35 U.S.C. 251 as interpreted by In re Doll and In re Graff, the patentee respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. 251, fourth paragraph.

### Summary

Applicant respectfully submits that this reissue application is ready for allowance and invites the Examiner to telephone the undersigned attorney if it appears that a telephone conference would further this case in any way.

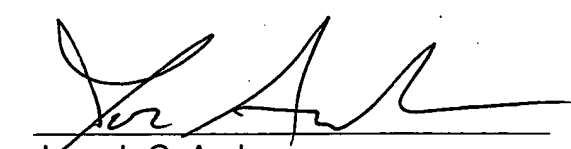
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Box Reissue, Assistant Commissioner for Patents, Washington, DC 20231** on

April 2, 2002

By Angela Williams

  
Signature  
April 2, 2002

Respectfully submitted,

  
Joseph C. Andras  
Registration No. 33,469  
MYERS, DAWES & ANDRAS LLP  
19900 MacArthur Blvd., Suite 1150  
Irvine, CA 92612  
(949) 223-9600